

REMARKS/ARGUMENTS

Applicants address the examiner's remarks in the order presented in the Office Action (dated March 24, 2004). All claim amendments are made without prejudice and do not represent an acquiescence in any ground of rejection.

STATUS OF THE CLAIMS

Claims 1-36 and 38-68 are pending in the application, with claims 8, 11-16, 20-23, 38-40, and 42-68 being withdrawn from consideration.

With this amendment, claim 25 and claims 45-68 have been canceled. Claims 1, 6, 7, 17, 19, 26, 27, and 31 have been amended. Therefore, claims 1-7, 9, 10, 17-19, 24, and 26-36 will be pending after entry of this amendment. Support for the amendments to claims can be found throughout the application as filed. For example, support for the amendment to claim 31 can be found at page 8, lines 18-29, and page 9, lines 1-15. No new matter is added by the amendments.

Claim 31 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention (written description rejection). Claims 1-7, 9, 10, 17-19, 24-36 and 41 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 1, 5, 6, 7, 9, 10, 17, 24-26, 29, 30, and 32-36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lerner *et al.* (U.S. Patent No 5, 601, 992).

REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH

Claim 31 was rejected under 35 U.S.C. § 112, first paragraph, as alleging containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention (written description rejection).

In order to expedite prosecution of this application, Applicants have amended claim 31, replacing the phrase "a so-called intelligent material responsive to a chemical or physical parameter" with "gelatin, polysaccharides such as agar and agarose, natural and synthetic

polymers such as methylcellulose, polyacrylamide, hydrogels, gels containing N-isopropylacrylamide, and thermo-sensitive polymers”.

Without acceding to the propriety of the rejection of the pending claims under 35 U.S.C. § 112, first paragraph, Applicants respectfully request reconsideration of claim 31 as amended. For these reasons, Applicants request the examiner to withdraw the rejection of pending claim 31 under 35 U.S.C. § 112, first paragraph.

REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 1-7, 9, 10, 17-19, 24-36 and 41 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

With respect to the elected species of solid support being film or tape, the examiner was of the opinion that claims 27, 28 and 41 were confusing because it was unclear to the examiner how the “film or tape” can be placed in individually identifiable containers or different compartments. Claim 41 was previously canceled. Applicants have amended claim 27 for greater clarity and consistency of claim language. Claim 28 is a dependent upon claim 27. Therefore, it is submitted that this rejection has been overcome by amendment. It is respectfully requested that the rejection of claims 27 (and dependent claim 28) under 35 U.S.C. § 112, second paragraph, be withdrawn.

The examiner was of the opinion that claim 6 was confusing because it was unclear to the examiner how the material “allows for spontaneous release of the analytes”. The examiner stated that the phrase was relative terminology which rendered the claim indefinite. Applicants have amended claims 6 and 7 for greater clarity and consistency of claim language. Therefore it is submitted that this rejection has been overcome by amendment. Applicants respectfully request that the rejection of claims 6 and 7 under 35 U.S.C. §112, second paragraph, be withdrawn.

The examiner stated that claims 17-19 were confusing because it was unclear to the examiner how the elected support of “film or tape” is coated with a membrane, monolayer or film (claim 17) or is an information carrier (claim 18) or is reflective (claim 19). Applicants have amended claims 17 and 19 for greater clarity and consistency of claim language. Claim 18 depends from claim 17 therefore contains all the limitations of this preceding claim.

Therefore it is submitted that this rejection has been overcome by amendment. Applicants respectfully request that the rejection of claims 17-19 under 35 U.S.C. §112, second paragraph, be withdrawn.

The examiner was of the opinion that claim 25 was confusing with respect to the elected species of solid support is film or tape, because it was unclear to the examiner how the single "film or tape" can be a rod or spherical shape. In addition, the examiner stated that claim 26 was confusing because it was unclear to the examiner how the single "film or tape" could be a rod or spherical shaped. In order to expedite prosecution, Applicants have canceled claim 25 and amended claim 26. Claim 26 was amended for greater clarity and consistency of claim language. Applicants respectfully request that the rejection of claims 25 and 26 under 35 U.S.C. §112, second paragraph, be withdrawn.

Claim 31 was rejected as indefinite for referring to "so-called intelligent material". As discussed above, Applicants have amended claim 31 for greater clarity and consistency of claim language. Therefore the rejection of claim 31 under 35 U.S.C. §112, second paragraph, should be withdrawn.

The examiner was of the opinion that claim 1 (and all claims dependent thereon) recites a method for the rapid screening of analytes. The examiner held the opinion that the term "rapid" was a relative terminology which rendered the claim indefinite. Applicants have amended claim 1, deleting the term "rapid" from the claim for greater clarity and consistency of claim language. Therefore the rejection of claim 1 (and all claims dependent thereon) under 35 U.S.C. §112, second paragraph, be withdrawn.

Without acceding to the propriety of the rejections of the pending claims under 35 U.S.C. § 112, second paragraph, Applicants respectfully request reconsideration of the claims as amended. For these reasons, Applicants request the examiner to withdraw the rejections of the pending claims under 35 U.S.C. § 112, second paragraph.

REJECTIONS UNDER 35 UNDER 35 U.S.C. § 102(B)

Claims 1, 5, 6, 7, 9, 10, 17, 24-26, 29, 30, and 32-36 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Lerner *et al.* (U.S. Patent No 5, 601, 992; hereinafter the '992 Patent). Applicants respectfully traverse the rejection, as the Lerner reference neither

anticipates or renders obvious Claims 1, 5, 6, 7, 9, 10, 17, 24-26, 29, 30, and 32-36. Applicants believe that due to the Lerner reference's inability to teach or suggest all limitations of the claims, no *prima facie* case of anticipation or obviousness can be established.

MPEP §2143 requires that "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The examiner stated that Lerner *et al.* discloses a method that reads on that of the Applicants' instant claims. Applicants respectfully submit that the disclosure of Lerner *et al.* does not anticipate, inherently or otherwise, or make obvious, the subject matter defined by the present claims because the Lerner *et al.* method differs from Applicants' claimed method.

Applicants' method uses analytes which are free. Lerner *et al.* requires beads containing peptide-analytes that are attached with linkers. In addition, these beads must be cleaved and there is no such requirement in Applicants' instant invention. Applicants' instant invention uses "analytes", not beads. Applicants' amended claim 1 reads: "A method for the screening of analytes, comprising the steps of: a) simultaneously applying a *plurality of analytes* to be screened onto at least one solid support such that the analytes remain isolated from one another..." Lerner *et al.* discloses using beads, not analytes. Therefore the cited reference cannot be said to disclose the invention as presently claimed in claim 1 and any other independent claim.

Since the cited art does not teach all of the elements of the amended claims, Applicant respectfully submits that the claims define patentably distinct subject matter, and request that the rejection be withdrawn.

Further, "[t]he fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." M.P.E.P. § 2112 (citations omitted, emphasis in original).

The teachings of the Lerner *et al.* fail to anticipate, inherently or otherwise, or make obvious, the subject matter of the present claims, and Applicants accordingly, respectfully

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request withdrawal of the rejection of Claims 1, 5, 6, 7, 9, 10, 17, 24-26, 29, 30, and 32-36 under §102(b).

Applicants' representative welcomes a telephone conference with the examiner to further discuss the differences between Lerner *et al.* and the instant invention if the examiner feels such a telephone conference would advance compact prosecution in the instant case.


CONCLUSIONS

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206.332.1380.

Respectfully submitted,

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